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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,904	01/25/2002	Hidetoshi Nishikawa	1217.1004D	7245

21171 7590 06/11/2003

STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

EXAMINER

KIM, PETER B

ART UNIT	PAPER NUMBER
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2851

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,904

Applicant(s)

NISHIKAWA, HIDETOSHI

Examiner

Peter B. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19 and 27 is/are rejected.
- 7) ☒ Claim(s) 20-26 and 28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/236,484.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 20 and 26 are objected to because of the following informalities:

According to page 101 of the specification, the light from light compensating means does not reach the scanning means only when the film is free of scratches. Since claim 20 depends on claim 19 which recites compensating for scratched film, the recitation of claim 20 seems indefinite and vague without specifying the circumstance in which the light from the light compensating means does not reach the scanning means.

Regarding claim 26, "said light emitting means" lack proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Kurtz (5,754,278).

Kurtz discloses a film scanner (1) comprising a first light source (10), scanning means (60) which register an image corresponding to an original image (42), and light compensating means (50) which compensates insufficient light quantity due to disturbance of a light by an

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irregularity in the surface of the film using the disturbance of the light path caused by the irregularity (col. 7, lines 31-53).

Claims 19 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunt (6,239,425).

Hunt discloses a film scanner (Fig. 1) comprising a first light source (4), scanning means (9r, 9b, 9g) which register an image corresponding to an original image (1), light condensing means (7) which condenses light incident thereon onto the scanning means through the film and light compensating means (10, 12, 13) which compensates insufficient light quantity due to disturbance of a light by an irregularity in the surface of the film using the disturbance of the light path caused by the irregularity (col. 8, line 67-col. 9, line 30).

Allowable Subject Matter

Claims 20-26, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the prior art of record teaches a film scanner of Claim 19 wherein the light compensating means are provided in a domain on the opposite side of the film from the scanning means (as in claim 20) or wherein the light compensating means are a second light source including a plurality of light emitting means (as in claim 21), or wherein the first light source includes a plurality of light emitting means having different respective spectral characteristics (as in claim 23), or wherein the light emitting means provided in the first light source and light compensating means are light emitting diodes (as in claim 26) or wherein the first light source

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and the light compensating means are moveable along a light axis between the first light source and the scanning means (as in claim 28).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Kim whose telephone number is (703) 305-0105. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays during the same hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams, can be reached on (703) 308-2847. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Peter B. Kim
Patent Examiner
June 6, 2003